

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Associate Commissioner for Patent Examination Policy and the
Technical Center Special Programs Examiner

In re Partial Patent Application of:
Michael Reed et al.

Serial No.:	08/113,955	Confirmation No.:	3543
Deposited:	August 31, 1993 [Filing Date Denied]	Art Unit:	[None Assigned]
For:	Multimedia Search System	Examiner:	[None Assigned]

**OPPOSITION TO JANUARY 5, 2010, "PETITION UNDER 37 CFR
1.181(a)(3) FOR SUPERVISORY REVIEW OF DECISION
DENYING PETITION FOR A FILING DATE"**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is an Opposition to the January 5, 2010, Petition for Supervisory Review of a Decision on Petition rendered October 9, 2009.

PETITIONERS – are Abraham Hershkovitz and Jon D. Grossman.

PETITIONERS' REAL PARTY IN INTEREST – is Encyclopaedia Britannica, Inc. ("Britannica"), although no assignment of Serial No. 08/113,955 appears to have been recorded.

OPPOSER – is Raymond W. Green, a Patent Attorney (Reg. No. 24,587) and shareholder of the law firm BRINKS HOFER GILSON & LIONE, P.O. Box 10395, Chicago IL 60610, 312-321-4200. BRINKS HOFER GILSON & LIONE represents defendants-appellees in litigation filed by Britannica, asserting patents that claim priority of Serial No. 08/113,955.

OPPOSER'S REAL PARTY IN INTEREST. This is a second protest in Serial No. 08/113,955 filed on behalf of Alpine Electronics, Inc. and Alpine Electronics of America, Inc.

SHOWING UNDER 37 CFR § 1.291(c)(5). This Opposition is deemed necessary to inform the Patent Office and the Associate Commissioner or his designee of important background facts and legal holdings that Britannica has withheld or mischaracterized. A fee under 37 CFR § 1.291(c)(3) and 37 CFR § 1.17(i) is submitted herewith.

ACTION REQUESTED. This Opposition should be entered into the file of Serial No. 08/113,955. The January 5, 2010, Petition should be dismissed as untimely; or, alternatively, as barred by *res judicata*, since the October 9, 2009, decision is now final and not subject to appeal. If not dismissed as untimely or as barred by *res judicata*, the Petition should be dismissed as seeking relief that the Patent Office has decided it has no statutory authority to grant; or, alternatively, as seeking relief that is impossible for the Patent Office to grant. If not dismissed, the Petition should be denied.

CONCURRENT LITIGATION – is outlined in Appendix A, pages A2-A3, Paragraphs 5-8, of an Opposition filed January 9, 2008. Attention is directed to these updates:

Encyclopaedia Britannica v. Alpine (I), Civil Action 05-cv-359, resulted in summary judgment that, *inter alia*, the only independent claim of U.S. Patent 5,241,671 was invalid for indefiniteness. Britannica appealed the decision to the Court of Appeals for the Federal Circuit, Appeal 2009-1087, which affirmed the District Court on December 4, 2009, 2009 WL 4458527.

Encyclopaedia Britannica v. Alpine (II), consolidated Civil Actions 06-cv-578 and 07-cv-787, resulted in summary judgment of invalidity of two patents that claim priority to (partial) application 08/113,955 under 35 U.S.C. § 102(b), because their effective priority date is by law no earlier than February 28, 1994, and Britannica itself published a patent application containing substantially-identical subject matter on May 16, 1991. 643 F.Supp.2d 874 (W.D. Tex. 2009). Britannica also appealed this decision to the Court of Appeals for the Federal Circuit, Appeals 2009-1544, and -1545, in which briefing was recently completed, and oral argument is awaited.

PRIOR PETITIONS FILED BY PETITIONERS IN THIS PARTIAL PATENT

APPLICATION – per the PAIR Transaction History for USSN 08/113,955, were entered 10-29-93, 11-1-07, 2-6-08, 8-6-08, 10-6-08, and 5-4-09.

The Image File Wrapper list of Available Documents recites petitions filed on 10-29-93 (2 pages), 1-7-94 (6 pages), 11-1-07 (9 pages), 11-2-07 (9 pages), 2-6-08 (6 pages), 2-6-08 (1 page), 2-19-08 (5 pages), 10-6-08 (2 pages), 10-6-08 (14 pages), 10-15-08 (37 pages), 10-15-08 (2 pages), 11-14-08 (15 pages), 11-14-08 (13 pages), 2-10-09 (17 pages), 2-10-09 (5 pages), 3-5-09 (14 pages), 3-5-09 (2 pages), 3-16-09 (5 pages), 5-4-09 (51 pages), 5-4-09 (22 pages), 5-4-09 (26 pages), 8-14-09 (18 pages), and 1-5-10 (32 pages).

The PAIR Transaction History and the IFW list of Available Documents recite that petitions were dismissed on 2-16-94, 8-6-08 and 3-4-09, and denied on 3-4-09 and 10-9-09.

The March 4, 2009, denial decision states “This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review.” The October 9, 2009, decision states “No further reconsideration or review of this matter will be undertaken.”

TO WHOM DIRECTED. The January 5, 2010, Petition is addressed to the “Associate Commissioner for Patent [Examination] Policy”; but it is identified in the PAIR Image File Wrapper as a “Petition for review by the Technical Center SPRE”, presumably by delegation.

1. The January 5, 2010, Petition is untimely

The January 5, 2010, Petition seeks review of a Decision rendered October 9, 2009, but it was filed almost one month too late and should be denied for that reason alone. 37 CFR § 1.181(f). The March 4, 2009, and October 9, 2009, Decisions were not appealed, and those Decisions are now *res judicata*, binding on Britannica.

The January 5, 2010, Petition is also, at least, Britannica’s fifth successive petition making essentially identical arguments. Each of four prior petitions has been exhaustively considered by the Patent Office, and properly dismissed or denied. For example, the Office of Petitions’ August 6, 2008, Decision denied all substantive grounds of this latest Petition on multiple grounds. In so doing, the Decision made clear that the Patent Office has no statutory authority to grant the Petition under any circumstances. The Decision went further, also making it clear that “[a]s over 13 years 8 months have passed between that action and the instant petitions, the instant petitions are dismissed as untimely” under 37 CFR § 1.181(f). (August 6, 2008, Decision at 6.) It appears that Britannica intends to inundate the Patent Office with successive petitions, hoping that the Patent Office will eventually relent and ignore the statutes and binding court holdings, giving Britannica an incorrect ruling on the merits that other parties must then get reversed through the Court system. To date, the Patent Office has avoided doing so and Opposer is confident that the Patent Office will continue to rule correctly. But Britannica’s strategy is particularly troubling and inappropriate coming at this time, because a District Court has already ruled against Britannica on these issues in an Order and Final Judgment, which is currently on appeal to the Federal Circuit. Thus it appears that Britannica is inviting the Patent Office to create new facts that it can (try to) inject into an ongoing appeal in order to reverse an already-final District Court decision. At the very least, it appears that

Britannica is posturing to be able to tell the Federal Circuit, “There is a petition pending in the Patent Office that addresses these issues.”

Opposer incorporates all of the arguments and facts recited in the prior oppositions to Britannica’s prior petitions by reference. The purposes of this Opposition are to (i) highlight that the Petition is untimely; (ii) inform the Patent Office and the Associate Commissioner or his designee of important background facts and legal holdings that Britannica has studiously withheld or mischaracterized; (iii) briefly set forth a more complete history of the petitions on this application, which is omitted from Britannica’s Petition to which this Opposition responds; and (iv) briefly record Opposer’s continued opposition to the relief sought by the Petition, and the bases for the Opposition.

Britannica filed at least its fourth Petition seeking a filing date for the 08/113,955 partial application on May 4, 2009. That Petition sought reconsideration and/or supervisory review of the Patent Office’s March 4, 2009, Decision denying Britannica’s October 6, 2008, Petition. The March 4, 2009, Decision was declared final for purposes of agency review, as Britannica acknowledged in its May 4, 2009, Petition. The Patent Office denied Britannica’s May 4, 2009, Petition on October 9, 2009. That denial explained that the March 4, 2009, decision “was a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. No further reconsideration or review of this matter will be undertaken.” But rather than seek judicial review, Britannica waited almost three months and then filed yet another Petition, this one accusing the Patent Office of “refus[ing] to reconsider the [May 4, 2009] Petition... [and] fail[ing] to forward the Petition for supervisory review.” (January 5, 2010, Petition, at 1).

Britannica argues that its January 5, 2010, Petition should be considered timely because “It has now become evident that the Deciding Official failed to forward the Petition of May 4, 2009, to a higher level PTO Official for Supervisory Review of the Denial.” (January 5, 2010, Petition, at 2). Britannica suggests that it did not know that the May 4, 2009, Petition would not be getting supervisory review until January 2010. But the Patent Office’s October 9, 2009, decision explained that “No further ... review of this matter will be undertaken.” That included supervisory review; 37 C.F.R. § 1.181(a)(3) states only that the Director’s supervisory review may be invoked “in appropriate circumstances.” Britannica was on notice on October 9, 2009, that no further review would be undertaken. If Britannica wished to request reconsideration of the October 9, 2009, decision not to review the matter further (setting aside whether such a

petition would be appropriate), it had to do so within two months. 37 CFR § 1.181(f). Having failed to do so, its January 5, 2010, Petition is untimely and should be denied on that basis.

2. Critical Facts that Britannica is Withholding or Obscuring from the Patent Office

Nature of District Court Decision and Final Judgment. In a footnote on page 6, Britannica mentions a District Court decision (in consolidated Civil Action 06-cv-578 and 07-cv-787) dated August 7, 2009 (*sic*; the District Court Memorandum Opinion and Order, 643 F.Supp.2d 874 (W.D. Tex. 2009), was dated August 3, 2009), effectively characterizing it as irrelevant. It is not irrelevant. The District Court's Final Judgment is currently on appeal. Unless reversed or vacated, the Judgment and Order, and the factual findings and legal holdings therein, are *res judicata* to Britannica and the application at issue here. Britannica is collaterally estopped from challenging them.

The District Court entered summary judgment of invalidity of two asserted patents that claim priority to application 08/113,955 under 35 U.S.C. § 102(b), because their effective priority date is by law no earlier than February 28, 1994, and Britannica itself published a patent application containing substantially-identical subject matter on May 16, 1991. 643 F.Supp.2d at 882. The crux of the District Court's determination of the applicable priority date was that “under Section 120 [of the Patent Act,] the 2nd Application [partial application 08/113,955] is not ‘similarly entitled to the benefit of the filing date’ of the 1st Application [application 07/426,917, now U.S. Patent No. 5,241,671] unless it specifically cross-references that application. Because the 2nd Application did not do so, *the 2nd Application was not entitled to any filing date.*” 643 F.Supp.2d at 881 (emphasis added).

The District Court also implicitly decided that no amendment of the abandoned '955 application is possible at this stage (as requested by the Petition), because no such amendment is allowed after an application is abandoned. In relevant part, the District Court held that the '955 application was not entitled to claim priority to the '671 patent because “*No claim of priority was filed* in the 2nd Application prior to March 23, 1995, the date the Patent Office issued a Notice of Abandonment for the 2nd Application.” 643 F.Supp.2d at 878 (emphasis added).

The District Court specifically considered the Patent Office's August 6, 2008, and March 4, 2009, rulings on Britannica's prior petitions – arguments which the current Petition merely repeats. The District Court specifically considered Britannica's argument that “the 2nd Application [*i.e.*, partial application Serial No. 08/113,955 at issue here] had a specification and

drawing, as required by the applicable statute, and thus was entitled to a filing date" and the prior 1993 Patent Office ruling was therefore unlawful. 643 F.Supp.2d at 881. The Court rejected that position, fully affirming the Patent Office's prior rejections of Britannica's petitions:

The Patent Office expressly concluded in two decisions on Britannica's petitions regarding the 2nd Application that the requirements of Section 120 were not met. *In re Application of Michael Reed, et al., Appl. No. 08/113,955, Ruling on Petition, Paper No. 17, at 7 (U.S.P.T.O. Aug. 6, 2008); In re Application of Michael Reed, et al., Appl. No. 08/113,955, Ruling on Petition, Paper No. 26, at 9 (U.S.P.T.O. March 4, 2009)*. The Patent Office's decisions interpret the statutory requirements of Section 120 to require that each application in the chain must individually meet the requirements of the statute, and that for any application to be entitled to the filing date of a prior-filed application, it must have been both filed before the prior-filed application and make explicit reference to the prior-filed application. See 35 U.S.C. § 120. See also *Clover Club Foods Co. v. Gottschalk*, 178 U.S.P.Q. 505, 508 (C.D. Cal. 1973). ***The Court finds no inconsistencies in the Patent Office's interpretation or application of Section 120 in this case.***

643 F.Supp.2d at 882 (emphasis added). The Court went on to rule on one of the questions specifically raised (again) by Britannica in the pending Petition: "the Court finds that the 3rd Application [U.S. Patent 6,546,399] is not entitled to the benefit of the filing date of the 1st Application [U.S. Patent 5,241,671] as the 2nd Application [08/113,955 at issue in this Petition] breaks the chain of priority." 643 F.Supp.2d at 882.

The District Court also specifically considered another argument Britannica raises (again) in this Petition, namely: "Britannica also argues that because the Patent Office allowed the 3rd Application to issue as a patent, with a claim of priority on its face to the 1st Application through the 2nd Application, any requirement that the 2nd Application contain a specific reference to the 1st Application was waived." 643 F.Supp.2d at 882, n.1. Britannica couches this argument several different ways in the current Petition, in terms of (i) public notice that Britannica already had priority (Petition at 5), and (ii) that Britannica and the Patent Office were allegedly unaware of the defect in the '955 Application because the PTO allowed prosecution of continuation applications (Petition at 9). But the District Court's Order and Final Judgment already rejected these arguments too, explicitly finding that the Patent Office's prior rejections of Britannica's petitions were in accord with Federal Law:

However, the Patent Office explicitly rejected this argument. In re Application of Michael Reed, et al., Appl. No. 08/113,955, Ruling on Petition, Paper No. 26, at 8-9 (U.S.P.T.O. Aug. 6, 2008). For the reasons previously stated in this opinion, *the Court finds the Patent Office's rulings in accord with the applicable federal statutes. Therefore the Court declines to disregard the Patent Office's determination on Britannica's waiver issue.*

643 F.Supp.2d at 882 n.1 (emphasis added).

The District Court Decision Was Based on Facts that Britannica Stipulated to be

True and Cannot Change Now. The District Court's Order and Final Judgment were based upon stipulated facts. See 643 F.Supp.2d at 887-79. Britannica fails to mention those stipulated facts. Among the stipulated facts was this: “**Stipulated Facts** … The specification of the 2nd Application [08/113,955] makes no reference to the 1st Application [the '671 Patent]. No claim of priority was filed in the 2nd Application prior to March 23, 1995, the date the Patent Office issued a Notice of Abandonment for the 2nd Application.” 643 F.Supp.2d at 877, 878.

Britannica has thus already stipulated to a fact that it seeks now to have the Patent Office change with this Petition.

An Appeal is Pending Before the Federal Circuit on All These Issues. Although the Petition fails even to mention it, these issues are now before the Court of Appeals for the Federal Circuit. Britannica appealed the Final Judgment on August 24, 2009, and briefing is now complete. The current Petition is an implicit attempt to inject new facts into the pending appeal. Britannica apparently hopes to undermine the District Court's final judgment by spurring the Patent Office to change the factual background of the appeal, *even though the District Court's decision was based upon facts stipulated by Britannica.*

There is no Application 08/113,955 to Amend. The file wrapper of abandoned application 08/113,955 contains no specification or drawings. Presumably, the Patent Office disposed of them long ago under the regulations in effect at the time:

If any application is filed without the specification ..., applicant will be so notified and given a time period within which to submit the omitted specification ... in order to obtain a filing date as of the date of filing of such submission. ... If the omission is not corrected within the time period set, the application will be returned or otherwise disposed of

37 CFR § 1.53(c) (1993), conveniently found in the Manual of Patent Examining Procedure, Fifth Ed., Rev. 16, March 1994. Thus, although the endgame relief sought by Britannica's Petition is amendment of the specification of the '955 Application, the specification *cannot be amended* because it no longer exists.

Britannica Made a Conscious Decision to Abandon the '955 Application Without Any Claim of Priority to the Earlier '671 Patent. The Petition states that "Applicant, the general public, and indeed the USPTO *were completely unaware* of this alleged imperfection [*i.e.* the inability of subsequent applications to claim priority through the Application due to the failure to complete the application or amend it with a reference to the prior application] until the issue was brought to light by an opposer to Applicant's continuing application(s) in recent litigation." Petition at 9. **Not true.** (a) After Britannica received the 1993 Notice of Incomplete Application, **Britannica was obviously aware.** In fact, Britannica and its attorneys made a conscious choice not to complete the application, not to amend it, and to abandon whatever fleeting viability it may once have had.¹ (b) **The USPTO was obviously aware** of the "alleged imperfection" when it sent a NOTICE OF INCOMPLETE APPLICATION, and a NOTICE TO FILE MISSING PARTS OF APPLICATION / NO FILING DATE in 1993, when it dismissed Britannica's first Petition in 1994, and when it sent a Notice that the Application was abandoned on March 23, 1995. (c) **The general public was obviously aware.** Otherwise, how did the "opposer to Applicant's continuing application(s) in recent litigation" know to raise the matter?

3. A Brief History of the Patent Office's Denials of the Petitions

Under "Background" in Britannica's present Petition, Britannica recites earlier petitions beginning in 2007. Petition at 3-4. The Petition repeatedly argues that Britannica was "completely unaware" of the lack-of-filing date and lack-of-continuity problems with the '955 Application until it became an issue in recent and ongoing litigation. Petition at 9, 19, 20, 21. **This is not the case.** The Patent Office has already considered this issue, and held unequivocally that Britannica was fully on notice of the lack-of-filing-date and no-reference-to-

¹ Britannica's Petition filed November 1, 2007, admits that the incomplete Application 08/113,955 "was eventually [intentionally] **permitted to go abandoned** ..." (page 3)(emphasis added).

earlier-application problems for more than a decade. The full history of the repeated, serial petitions on this subject makes that much clear.

The First Petition. Britannica deposited an incomplete application later designated with Serial No. 08/113,955 (the so-called 2nd Application) with the Patent Office, on August 31, 1993. As Britannica has stipulated, the specification of this application made no claim of priority, and Britannica failed to submit the required declarations or the filing fee. The Patent Office sent Britannica a 1993 Notice of Incomplete Application, specifically stating that the 2nd Application had not been assigned a filing date. Britannica then filed a petition (the First Petition, October 29, 1993), asking for a filing date. The Patent Office dismissed that Petition on February 15, 1994, with instructions to Britannica on how to remedy the issue. Britannica never responded to the dismissal, and Britannica intentionally abandoned the 2nd Application.

The Second Petition. Thirteen years later, on November 1, 2007, when Britannica attempted to assert related patents in litigation and the accused infringers moved for summary judgment of invalidity, Britannica petitioned the Patent Office again. The November 2007 Petition was extraordinary by any measure, and on August 6, 2008, the Petitions Examiner correctly dismissed it, holding that the statutory requirements were not met and the Patent Office had no authority to act in derogation of a Federal Statute; that the Petition was untimely; that the '955 Application failed to reference any prior application, did not authorize payment of filing fees, and was not co-pending; and that no filing date could be granted under any of Petitioner's theories. The Patent Office affirmed that "the instant application was never accorded a filing date" because the application lacked at least the first page of the specification. (See August 6, 2008, PTO Dismissal at 1, 7). The Patent Office further held that Britannica failed to follow the Patent Office's instructions to remedy its failure to file a complete application, then waited fourteen years to seek any other relief, and that Britannica is barred by statute from receiving any relief now. *Id.*

The Third Petition. Undeterred, Britannica filed a Request for Reconsideration and Request for Grant of a Filing Date (in essence, another Petition with the same arguments) on October 6, 2008. The Patent Office denied that Petition on March 4, 2009, again concluding that Britannica had failed to meet the requirements of any of the applicable statutes, and that its request was untimely, coming over 13 years after the Patent Office's original denial.

The Fourth Petition. Britannica filed yet another request for reconsideration on May 4, 2009. The Petition raised exactly the same arguments, again. In a decision dated October 9, 2009, the Patent Office dismissed the Petition, noting that the prior denial was already a final agency action, fully appealable by Britannica when it was rendered.

The Fifth Petition. The present Petition, January 5, 2010, is at least the fifth Petition by Britannica asserting exactly the same arguments.

4. Basis for Opposition to the Petition

There are many reasons why the present Petition should be denied. First of all, it is untimely. And by its own stipulation, Britannica repeatedly failed to follow the statutory and Patent Office procedures when it deposited this Application in 1993:

- It filed the application without a claim of priority;
- It failed to respond to the Patent Office's directions to fix an incomplete application after the Notice of Incomplete Application in 1993;
- It failed to respond to or appeal the Patent Office's dismissal of its First Petition in 1994;
- It failed to ever submit the required declaration or fees;
- It failed to respond to the Notice of Abandonment in 1995; and
- It intentionally allowed the application to go abandoned.

These failures provide ample support for the Patent Office's repeated denials, but additional reasons exist as well.

First, as the Patent Office has repeatedly held, it is barred by statute from granting the relief requested by Britannica. "The requirements of 35 U.S.C. 111 and 35 U.S.C. 120 have not been met. Petitioner is reminded that no Executive branch agency may act in derogation of a federal statute." (August 6, 2008, Decision, at 7.)

Second, a District Court order and final judgment have affirmed the Patent Office's reading and application of Section 120 of the Patent Act. As a final judgment, that order and its supporting factual and legal findings are binding on Britannica.

Third, as stated by the Patent Office on October 9, 2009, the previous dismissal was a final agency determination. If Britannica wished to challenge it, its proper course was to appeal that final agency determination. It did not, and it is now too late to do so.

Fourth, the unappealed 1994 dismissal of Britannica's first Petition is also binding on Britannica. Had Britannica wished to appeal the Patent Office's determination of no filing date for this application, the proper time to do so was in 1994, not 16 years later.

Fifth, the Patent Office could not grant the requested relief, even if it were not barred by statute and prior determinations by itself and the District Court. The whole point of the Petition is not just to get a filing date – but to amend the specification of the application to overcome the District Court's determination that no priority can be claimed through this application because the application itself lacked any reference to the prior application. See Petition at 30. But, as stated above, there is no specification to amend. With no specification to amend, Britannica's request to amend it is impossible and thus moot.

Sixth, no amendment would be lawful at this juncture anyway. The amendment is being requested now. No matter how one reads the pre-1999 version of Section 120 of the Patent Act, the 1999 amendments to Section 120 specifically forbid this kind of after-abandonment amendment to add a non-recited priority or change a recited priority. “No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director.” 35 U.S.C. § 120. The '955 application is not currently pending; even if the Petition were granted, the application would still not be pending because it was abandoned in 1995; and the specification, discarded pursuant to regulations in effect at that time, cannot be amended to reference an earlier application now, after it has been abandoned.

CONCLUSION

The January 5, 2010, Petition should be dismissed as untimely or on alternate grounds; or, if not dismissed, the Petition should be denied.

Respectfully submitted,

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March 8, 2010

CERTIFICATE OF SERVICE

I certify that on March 8, 2010, copies of the foregoing Opposition and the accompanying document authorizing a charge to Opposer's Deposit Account were served by first class mail, postage prepaid, to:

- (1) Jon D. Grossman, Dickstein Shapiro LLP, 1825 Eye Street, Washington DC 20006-5403; and
- (2) Abraham Hershkovitz, Hershkovitz & Associates, LLC, 2845 Duke Street, Alexandria, VA 22314.

/Raymond W. Green/
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